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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/585,669

06/01/2000

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673-1005

4523

23644 7590 05/30/2007

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EXAMINER

MILLS, DONALD L

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/585,669	<b>Applicant(s)</b> MORAN, THOMAS	
	<b>Examiner</b> Donald L. Mills	<b>Art Unit</b> 2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 35-42, 43-51, 58, and 60-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda.

Regarding claims 35, 51, 60, and 62, Beyda discloses subconference calling, which comprises:

*Forming a main conference between a plurality of users* (Managing subconference calls within a main conference. See Abstract;)

*Presenting at least one of said users in the main conference with a list of the main conference participants* (Referring to Figures 1 and 2, the a list of users is presented to an user in order for them to determine an appropriate subconference participant. See column 5, lines 31-41;)

*Providing said user with an interface to interact with said list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said list using said interface* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the known list of participants. See column 4, lines 33-40;)

*Forming a subconference between the user and the subset of other users* (The subconference call subsystem 30 establishes a first subconference call. See column 4, lines 52-54;)

*Maintaining private from the main conference at least some communication between the subset of users in the subconference during the subsistence of the subconference* (Referring to Figure 2, data router 36 transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

*Presenting to said user a graphical list of the subset of users in the subconference, when the subconference is in progress* (Referring to Figures 1 and 2, the list of the subset of users in the subconference is presented during the text messaging between the initiator and the intended recipient during the subconference between the first terminal 14 and the sixth terminal 24. See column 4, lines 66-67 and column 5, lines 1-3.)

Beyda does not disclose *presenting at least one of said users in the main conference with a graphical list of the main conference participants.*

Although Beyda does not explicitly disclose “presenting a graphical list of the main conference participants to a user,” Beyda does teach that traditional conference management systems comprise a coordinator computer terminal which displays the names and telephone numbers of all parties in the call (See column 1, lines 66-67 to column 2, lines 1-2.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement a “graphical list of the main conference participants” in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a

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straightforward and efficient means to allow a main conference participant to request another party to engage in a subconference call as taught by Beyda (See column 2, lines 9-14.)

Regarding claim 36, the primary reference further teaches *wherein those users in the subconference are entirely isolated from participation in the main conference during the subsistence of the subconference* (Referring to Figure 2, data router 36 transmits voice data generated from the first terminal 14 and sixth terminal 24 over the first subconference call but not over the main conference call. See column 4, lines 66-67 and column 5, lines 1-3.)

Regarding claim 37, the primary reference further teaches *wherein the users in the subconference are prevented from contributing to the main conference but are able to monitor communications in the main conference during the subsistence of the subconference* (Voice data generated from first terminal 14 and sixth terminal 24 are transmitted only to participants in the subconference call and voice data from the main conference call is transmitted to all terminals. See column 4, lines 57-62.)

Regarding claims 38 and 61, the primary reference further teaches *wherein the main conference utilizes a plurality of media types, users in the subconference utilize one or more of said media types, and users in the subconference can actively or passively participate in the main conference in at least one media type during the subsistence of the subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 39, the primary reference further teaches *wherein the users utilize a plurality of media types in the main conference and/or subconference, said media types being selected from the group consisting of vide, audio and data signals* (Users in the subconference

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can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 40, the primary reference further teaches *wherein the media types utilized in the main conference include video and audio, and wherein the subconference utilizes audio signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 41, the primary reference further teaches *wherein the media types utilized in the main conference include audio and data, and wherein the subconference utilizes data signals* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claims 42 and 58 as explained in the rejection statement of claims 35 and 51, Beyda discloses all of the claim limitations of claims 35 and 51 (parent claim).

Beyda does not disclose *wherein the users in the main conference are presented with said subconference list during the subsistence of the subconference.*

Beyda teaches that when a coordinator drops parties from the conference call to establish a subconference call, the other coordinators in the call are able to detect that some parties have been dropped (See column 2, lines 2-5.)

It would have been an obvious choice in design to one of ordinary skill in the art at the time the invention was made to allow users in the main conference to see the list of subconference users. One of ordinary skill in the art at the time the invention was made would have been motivated to do so in order for users to establish subconferences with any user present in the conferencing system.

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Regarding claim 43, Beyda disclose *wherein the users in the main conference are not presented with said subconference list during the subsistence of the subconference* (Referring to Figures 2, 3, and 6, the subconference subsystem prevents any second voice data 38 from the first subconference call from being transmitted over the main conference call. See column 6, lines 61-63. And, the subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals in the main conference call. See column 4, lines 54-57.))

Regarding claim 44, the primary reference further teaches *wherein the main conference is formed on a conference bridge to which each of the main conference users is connected* (The main conference is routed a data router 36, or by a switch, hub, or bridge where the IP telephony terminals are connected. See column 4, lines 20-26.)

Regarding claim 45, the primary reference further teaches *wherein the subconference users remain connected to the bridge and the subconference is formed by creating a second conference on the bridge simultaneously with the main conference* (The subconference call subsystem 30 establishes the call in a manner that is transparent to the other terminals 16, 18, 20, and 22 in the main conference call, which inherently resides on the same data router 36. See column 4, lines 54-57.)

Regarding claim 46, the primary reference further teaches *wherein the user(s) to whom the request is addressed have the option of accepting or refusing to join the subconference, and wherein such acceptance or rejection determines whether or not they remain as part of said subset* (After transmitting the request to the sixth terminal 24, the subconference call subsystem 30 monitors for an acceptance to the call set-up request which can be accepted or rejected, which

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inherently determines whether the sixth terminal **24** forms a subconference with the first terminal

**14.** See column 4, lines 50-52.)

Regarding claim 47, the primary reference further teaches *wherein each user in the subconference is provided with the option to leave the subconference at any time during the subsistence of the subconference* (Referring to Figure 5, when a subconference call is established, at any time during the subconference call, any terminal participating in the subconference call can transfer to bi-directional transmission within the main conference call. See column 6, lines 27-30.)

Regarding claim 48, the primary reference further teaches *wherein users opting to leave the subconference are automatically returned to full participation in the main conference* (Any terminal that can transfer among each of its subconference calls and the main conference call. See column 6, lines 30-34.)

Regarding claim 49, the primary reference further teaches *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to join a nested subconference within said initial subconference* (Referring to Figures 3, 4, 5, and 7, the subconference subsystem **30** monitor the main conference call and the first subconference call for a second request to establish a second subconference call. See column 7, lines 6-10.)

Regarding claim 50, the primary reference further teaches *wherein users in the subconference are presented with the option of requesting one or more of the other subconference users to leave said initial subconference and from a new subconference without rejoining the main conference* (Referring to Figure 5, the fourth terminal **20** can establish a



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second subconference call from either the first subconference call or the main conference call.

See column 6, lines 14-16.)

Regarding claim 63, the primary reference further teaches *means for enabling the user to select one or more media types for use during said subconference* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 64, the primary reference further teaches *when embodied in a multimedia terminal for use in a conference* (Referring to Figure 2, multimedia terminals 14 and 24.)

Regarding claim 65, the primary reference further teaches *when embodied in the form of a telephone handset having a graphical display for presentation of said graphical list and input means for operation of said interface* (Referring to Figure 2, multimedia terminals 14 and 24.)

3. Claims 52-55, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 6,404,873 B1) in view of Hamilton (US 6,757,259 B1).

Regarding claim 52 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the main conference list memory unit and the subconference list memory unit are logical areas within a single memory unit*.

Hamilton teaches a conference bridge comprising all memory within a central unit (See Figure 1.)

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the memory units as a single memory unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 53 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose *wherein the functions of the main signal processing means and of the subconference signal processing means are carried out by the same signal processing unit.*

Hamilton teaches a conference bridge comprising all signal processing within a central unit (See Figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the signal processing as a single signal processing unit of Hamilton in the subconferencing system of Beyda. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to simplify system design, reduce system costs, and improve efficiency.

Regarding claim 54, the primary reference further teaches *wherein said signal processing unit is adapted to combine signals of different media types* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 55, the primary reference further teaches *wherein said media types are selected from video, audio and data* (Users in the subconference can utilize video, audio, and whiteboard data from the main conference call. See column 5, lines 22-26.)

Regarding claim 57, the primary reference further teaches *wherein said main control unit includes means for forwarding said list of users in the conference to each of the users* (Referring to Figure 1, first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based upon the inherently known list of participants. See column 4, lines 33-40.)

Regarding claim 59, the primary reference further teaches *a conferencing server connected to the conferencing server, and means for connecting users to the call server* (Managing subconference calls within a main conference. See Abstract.)

4. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (US 6,404,873 B1), hereinafter referred to as Beyda in view of Hamilton, further in view of Theimer et al. (US 5,812,865), hereinafter referred to as Theimer.

Regarding claim 56 as explained in the rejection statement of claim 51, Beyda discloses all of the claim limitations of claim 51 (parent claim).

Beyda does not disclose the *subconference control unit being dynamically programmable causing said subconference signal processing means to generate outgoing signal streams containing a user selected combination of media types selected from the incoming signals for the users subconference.*

Theimer selectively establishing communications paths between media devices based on the context of the users. For example, user<sub>A</sub> may set up an electronic conference with user<sub>B</sub>.

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User<sub>A</sub> may specify that a video connection is preferred, and user<sub>A</sub> may also accept telephone, or voice only, connection (See column 27, lines 33-46.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the selective communications path method of Theimer in the system of Beyda. One of ordinary skill in the art would have been motivated to do so in order to provide a system which allows users to select media data paths between users to tailor conferences to a user's capabilities as taught by Theimer (See column 4, lines 10-13.)

### ***Response to Arguments***

5. Applicant's arguments filed 21 March 2007 have been fully considered but they are not persuasive.

#### **Rejection Under 35 USC 103**

On page 3 of the remarks, regarding claim 35, the Applicant argues Beyda does not disclose *presenting at least one of said users in the main conference with a list of main conference participants; providing the user with an interface to interact with said list of main conference participants, such that said user has an option to request a subconference with a subset of other users by selecting subconference participants from said list using said interface; and presenting to said user a list of the subset of users in the subconference, when the subconference is in progress.* The Examiner respectfully disagrees. Beyda implies a list of users is presented to an user in order for them to determine an appropriate subconference participant (See column 5, lines 31-41.) The Examiner provides the following reasoning. Beyda teaches that the advances in telecommunications have made available teleconferencing features that

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more closely approximate a face-to-face meeting for individuals who are located at substantial distances from each other (See column 1, lines 11-23.) Beyda further teaches that what is needed is a system and a method for transparently establishing subconference calls during a conference call in a manner which enables the subconference call parties to receive voice information from the conference during the subconference (See column 2, lines 9-10,) which is an improvement upon the system of Bales that employs a display. In addition, Beyda discloses that the telephony conference call is established utilizing convention IP telephony methods in which users may request a subconference call; these systems utilize either a traditional auditory or visual list (See column 2, lines 26-40.) Therefore, the utilization of a list is implied for the establishment of a conference and subconference call. Essentially, the Applicant argues for an unreasonable interpretation of Beyda by ignoring necessary fundamental processes, which would render the system inoperable. Especially, since Beyda's system and method are an improvement upon the traditional systems as described in column 1, line 37 to column 2, line 5.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Mills whose telephone number is 571-272-3094. The examiner can normally be reached on 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Donald L Mills



May 25, 2007



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SUPERVISORY PATENT EXAMINER  
5/29/07